

Notice of Allowability

Application No.

09/824,510

Examiner

Nicholas D. Rosen

Applicant(s)

TILEY ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/11/2005.
2. ☒ The allowed claim(s) is/are 1-40 and 42-55.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____



Claims 1-40 and 42-55 have been examined.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with attorney James Porcelli on September 16, 2005.

The examiner's amendment includes an increase in the number of claims. Mr. Porcelli authorized charging any additional fee for the new claims to deposit account 23-0650, the deposit account of the Webb Law Firm.

The application has been amended as follows:

Claim 1 is amended as follows: In the first line of claim 1, "A method" is hereby amended to "**A computer-implemented method**". In the third line of claim 1, "a) identifying, with the use of a computer," is hereby amended to "**a) identifying, with the use of a computer which accesses a database**". In the eighth line of claim 1, "b) compiling, through an administrator or supplier using a computer," is hereby amended to "**b) compiling, using a computer which access a database,**". In the twelfth line of claim 1, "c) providing, through an administrator or supplier using a computer," is hereby amended to "**c) providing, using a computer,**".

Claim 21 is hereby amended to read as follows, in its entirety:

21. The method according to claim 14 further including the step of motivating the individual to voluntarily provide individual information, wherein the step of motivating is comprised of one from the group of:

- a) providing free shipping of the product to the retail outlet;**
 - b) providing reduced cost for shipping the product to the retail outlet;**
- and**
- c) providing free shipping of the product to the retail outlet in exchange for a guaranteed purchase in the retail outlet.**

Claim 22 is hereby amended to read as follows, in its entirety:

22. The method according to claim 14 further including the step of motivating the individual to voluntarily accept target marketing, wherein the step of motivating is comprised of one from the group of:

- a) providing free shipping of the product to the retail outlet;**
 - b) providing reduced cost for shipping the product to the retail outlet;**
- and**
- c) providing free shipping of the product to the retail outlet in exchange for a guaranteed purchase in the retail outlet.**

In the second line of claim 32, "product pick up of a product from outlet inventory" is hereby amended to read **"product pick up"**.

Claim 35 is hereby amended to read as follows, in its entirety:

35. The method according to claim 34 wherein the step of providing motivation is comprised of at least one from the group of:

- a) providing free shipping of the product to the retail outlet;**
 - b) providing reduced cost for shipping the product to the retail outlet;**
- and**
- c) providing free shipping of the product to the retail outlet in exchange for a guaranteed purchase in the retail outlet.**

Claim 36 is amended as follows. In the first line of claim 36, "A method" is hereby amended to "**A computer-implemented method**". In the fourth line of claim 36, "a) identifying, using a computer," is hereby amended to "**a) identifying, using a computer which accesses a database,**". In the seventh line of claim 36, "b) identifying, using a computer," is hereby amended to "**b) identifying, using a computer which accesses a database,**".

Claim 40 is hereby amended to read as follows, in its entirety:

40. The method according to claim 36 wherein the individual is motivated to a) provide information, b) select a particular retail outlet for product pick up or c) accept target marketing and such motivation is comprised of at least one from the group of:

- a) providing free shipping of the product to the retail outlet;**
 - b) providing reduced cost for shipping the product to the retail outlet;**
- and**

c) providing free shipping of the product to the retail outlet in exchange for a guaranteed purchase in the retail outlet.

Claim 41 is hereby cancelled without prejudice or disclaimer.

New claims 48-55 are added as follows:

48. The method according to claim 14 further including the step of motivating the individual to voluntarily provide individual information, wherein the step of motivating is comprised of one from the group of:

a) providing the opportunity for the individual to use the retail outlet for product pick up or product delivery to another location; and

b) providing an opportunity for the individual to select the most convenient retail outlet in which to pick up a product from among a plurality of outlets.

49. The method according to claim 14 further including the step of motivating the individual to voluntarily provide individual information, wherein the step of motivating is comprised of one from the group of:

a) providing to the individual in-store credits or discounts for merchandise in the retail outlet;

b) providing a cash award to the individual;

c) providing a free gift or item or service to the individual;

- d) subsidizing the cost of the product thereby providing to the individual a reduced price for the product to be picked up;**
- e) providing the individual with product return services;**
- f) providing the individual with the opportunity to inspect the product before it is picked up;**
- g) providing the individual with the opportunity to delay payment until actually receiving the product;**
- h) providing the individual with the opportunity to withhold payment if the product is not acceptable; and**
- i) providing free or reduced fee escrow and inspection service for the product.**

50. The method according to claim 14 further including the step of motivating the individual to voluntarily accept target marketing, wherein the step of motivating is comprised of one from the group of:

- a) providing the opportunity for the individual to use the retail outlet for product pick up or product delivery to another location; and**
- b) providing the individual to select the most convenient retail outlet in which to pick up a product from among a plurality of outlets.**

51. The method according to claim 14 further including the step of motivating the individual to voluntarily accept target marketing, wherein the step of motivating is comprised of one from the group of:

- a) providing to the individual in-store credits or discounts for merchandise in the retail outlet;
- b) providing a cash award to the individual;
- c) providing a free gift or item or service to the individual;
- d) subsidizing the cost of the product thereby providing to the individual a reduced price for the product to be picked up;
- e) providing the individual with product return services;
- f) providing the individual with the opportunity to inspect the product before it is picked up;
- g) providing the individual with the opportunity to delay payment until actually receiving the product;
- h) providing the individual with the opportunity to withhold payment if the product is not acceptable; and
- i) providing free or reduced fee escrow and inspection service for the product.

52. The method according to claim 34 wherein the step of providing motivation is comprised of at least one from the group of:

- a) providing the opportunity for the individual to use the retail outlet for product pick up or product delivery to another location; and
- b) providing an opportunity for the individual to select the most convenient retail outlet in which to pick up a product from among a plurality of outlets.

53. The method according to claim 34 wherein the step of providing motivation is comprised of at least one from the group of:

- a) providing to the individual in-store credits or discounts for merchandise in the retail outlet;**
- b) providing a cash award to the individual;**
- c) providing a free gift or item or service to the individual;**
- d) subsidizing the cost of the product thereby providing to the individual a reduced price for the product to be picked up;**
- e) providing the individual with product return services;**
- f) providing the individual with the opportunity to inspect the product before it is picked up;**
- g) providing the individual with the opportunity to delay payment until actually receiving the product;**
- h) providing the individual with the opportunity to withhold payment if the product is not acceptable; and**
- i) providing free or reduced fee escrow and inspection service for the product.**

54. The method according to claim 36 wherein the individual is motivated to a) provide information, b) select a particular retail outlet for product pick up or c) accept target marketing and such motivation is comprised of at least one from the group of:

- a) providing the opportunity for the individual to use the retail outlet for product pick up or product delivery to another location; and
- b) providing an opportunity for the individual to select the most convenient retail outlet in which to pick up a product from among a plurality of outlets.

55. (New) The method according to claim 36 wherein the individual is motivated to a) provide information, b) select a particular retail outlet for product pick up or c) accept target marketing and such motivation is comprised of at least one from the group of:

- a) providing to the individual in-store credits or discounts for merchandise in the retail outlet;
- b) providing a cash award to the individual;
- c) providing a free gift or item or service to the individual;
- d) subsidizing the cost of the product thereby providing to the individual a reduced price for the product to be picked up;
- e) providing the individual with product return services;
- f) providing the individual with the opportunity to inspect the product before it is picked up;
- g) providing the individual with the opportunity to delay payment until actually receiving the product;
- h) providing the individual with the opportunity to withhold payment if the product is not acceptable; and

i) **providing free or reduced fee escrow and inspection service for the product.**

Allowable Subject Matter

Claims 1-35, 42-44, and 48-53 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, the anonymous article, "Babbage's Expands Online," discloses a method for creating target marketing opportunities, in a way, comprising: (a) identifying, using a computer, an individual known (or at least reasonably believed) in advance to visit a retail outlet to pick up a product. However, "Babbage's" discloses the retail outlet being a brick-and-mortar store of the chain from which the product is purchased; the seller is not unrelated by ownership to the specific retail outlet. The Packagenet system, as taught by Galler ("IP: Digital Commerce: Is Delivery the Dealbreaker for E-Commerce"), involves users visiting retail outlets to pick up products shipped from unrelated sellers, but there is no suggestion of creating target marketing opportunities by (b) compiling, information on the individual intending to visit the specific retail outlet to pick up a product, wherein at least a portion of the information is provided by the individual at the time the order is placed for the product to be shipped. Compiling information on individuals for target marketing is well known (as disclosed, for example, by O'Brien et al., U.S. Patent 5,832,457), but O'Brien does not disclose or suggest such a specific application as is recited in claim 1. Furthermore, neither "Babbage's," Galler, O'Brien, nor any other prior art of record discloses combining (a) and (b) with (c)

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providing, using a computer at least a portion of that individual information to a marketing entity for target marketing directed to the individual before visiting the retail outlet, surely not with the disclosed nature of the visit to the retail outlet.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 36-40, 45-47, 54, and 55 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, the anonymous article, "Babbage's Expands Online," discloses a method for target marketing to individuals known (or at least with good reason expected) to be visiting within a future time period a specific retail outlet, comprising (a) identifying, using a computer, an individual intending to visit the retail outlet to pick up a product; and (c) directing target marketing to the individual before visiting the retail outlet. However, "Babbage's" discloses the retail outlet being a brick-and-mortar store of the chain from which the product is purchased; neither "Babbage's" nor any other prior art of record discloses such target marketing before an individual's visit to the retail outlet when the individual intends to visit the retail outlet to pick up a product shipped from a seller unrelated by ownership to that specific retail outlet. The Packagenet system, as taught by Galler ("IP: Digital Commerce: Is Delivery the Dealbreaker for E-Commerce"), involves users visiting retail outlets to pick up products shipped from

unrelated sellers, but there is no suggestion of directing target marketing to the users before their visits to the retail outlets based on the knowledge that they will visit the retail outlets, and no suggestion or motivation in any prior art of record, or in the knowledge generally available to one of ordinary skill in the art of commerce, to combine these references.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN

PRIMARY EXAMINER

September 16, 2005